

DETAILED ACTION

1. The response of 8/18/08 was received and considered.
2. The IDS of 8/18/08 was received and considered.
3. Claims 1-5, 8-9, 11-20 & 35-50 are pending.

Claim Objections

4. Claims 4-5, 8-9, 11-13 & 16-20 are objected to because of the following informalities.

Appropriate correction is required.

- a. Regarding claim 4, line 6, the limitation “second user authentication” should be replaced with “second user authentication method”.
- b. Regarding claim 4, line 9, “authentication methods” should be replaced with “user authentication methods”.
- c. Regarding claim 4, line 10, “first authentication” should be replaced with “first user authentication”.
- d. Regarding claim 16, “wherein one authentication” should be replaced with “wherein one user authentication”.
- e. Regarding claim 18, “wherein one authentication” should be replaced with “wherein one user authentication”.
- f. Regarding claim 35, line 6, “a” should be replaced with “an”.
- g. Regarding claim 35, line 8, “by” should be replaced with “from”.
- h. Regarding claim 40, “the data” should be replaced with “at least some of the data”.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 42-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

i. Regarding claim 42, the claim is directed to web sites, which according to the specification (p. 8) are software, and hence the claimed invention does not fall within one of the statutory classes of invention defined under 35 U.S.C. §101. Claims 43-48 are rejected under similar rationale.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 42-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 42-48, the specification does not recite “authentication module”.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 14-16, 18 & 49-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

j. Regarding claims 14-15, the claims depend upon claim 10, which has been cancelled.

k. Regarding claim 16, the claim recites "wherein on authentication method employs a fixed complex code", however, claim 4 recites that the first user authentication method is either something a user knows or a characteristic of the user, which does not apply to a fixed complex code, thus rendering the claim unclear.

l. Regarding claim 18, the claim recites "wherein on authentication method is software based", however, claim 4 recites that the first user authentication method is either something a user knows or a characteristic of the user, which does not apply to a fixed complex code, thus rendering the claim unclear.

m. Regarding claims 49 & 50, the claim recites "adding a second factor of authentication to a first web site having a first factor of authentication", however, a "factor" in the spec is a piece of data and therefore it is unclear how this method "adds" the data to a first web site.

n. Regarding claims 49 & 50, it is unclear what limitation "as a function ..." modifies; if the receiving step is contingent upon the authorization, then it is unclear if the receiving step is performed.

o. Regarding claims 49 & 50, the limitation “transmitting data to the first web site indicating the user has been successfully authenticated using at least two factors of authentication” is unclear because the only mention of the first web site is that it has “a first factor of authentication”. The claim does not recite a first authentication being performed, only an authorization. Further, it is unclear how the data from the second web site indicates that the user is authenticated based on at least two factors when the second web site only authorizes based on a single factor.

p. Regarding claim 50, the limitation “the authorization website” (line 10) lacks sufficient antecedent basis. For the purposes of this action, the limitation is understood to read “the authentication website”.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 49-50 are rejected under 35 U.S.C. 102(b) as being anticipated by “RSA Web Security Portfolio – How RSA SecurID Agents Can Secure Your Website”, by RSA Security, Inc. (RSA).

Regarding claim 49, RSA discloses distributing a token to a user (p. 2, ¶2 and right column, §RSA SecurID Authentication Devices), providing a second website to authorize the user based on the token (RSA ACE/Server validates the PASSCODE, p. 2, §III, ¶2), receiving

authorization data at the second web site from the first website (receiving PASSCODE from the RSA ACE/Agent to the RSA ACE/Server, p. 2, §III, ¶2), the authorization data including user identification data (PASSCODE, p. 2, §III, ¶2) as a function of the first web site (ACE/Agent) authorizing the user (receiving the user ID, PIN and token code, p. 2, §III, ¶2), authorizing the user at the second web site (ACE/Server validates PASSCODE, p. 2, §III, ¶2) based on the token (token code, p. 2, §III, ¶2) and the user identification data (PASSCODE containing user ID and PIN, p. 2, §III, ¶2), and if the authorization at the second website is successful (PASSCODE is validated, p. 2, §III, ¶2), transmitting data (inherent because RSA ACE/Agents guard access to web resources, p. 2, §3, ¶1 and RSA ACE/Server validates the PASSCODE; i.e. there must be a communication from the server to the agent to allow access to services protected on the server) to the first web site indicating the user has been successfully authenticated using at least two factors (PIN and token code, p. 2, ¶1 and §III, ¶1) of authentication, wherein the user is granted access to web content (p. 2, ¶2 and right column, §RSA ACE/Agents for Web Platforms) on the first web site (web server protected with ACE/Agent, p. 2, §III, ¶¶2-3 and p. 2, ¶2 and right column, §RSA ACE/Agents for Web Platforms) only if the user has been authenticated using at least two factors of authentication (PASSCODE is validated, p. 2, ¶1 and §III, ¶¶1-2).

Regarding claim 50, the claim is substantially equivalent to claim 49, but recites "a plurality of websites". RSA discloses a single RSA ACE/Server (authorization web site) employed by a plurality of web sites (ACE/Agents, p. 6, Fig. entitled "RSA SecurID Web Topography).

13. Claims 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47 & 48 of this application conflict with claims 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25 & 26, respectively, of Application No. 11/678,921. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

14. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

15. Claims 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47 & 48 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25 & 26, respectively, of copending Application No. 11/678,921. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. However, it is noted that the '921 claims have been passed to issue.

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 4, 5, 8 & 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 11/678,921. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following analysis:

Regarding claim 4, the '921 application's claim 9 recites two authentication methods, the first being what a user knows (password, claim 9) and the second being a token distributed to a user (claim 8), communicating authentication data for both methods to a first web site (user entering token code and password, claim 8), authenticating the user at the first web site using the first authentication method (authenticating user based on second factor, claim 8), , if the user is authenticated, communicate the token-based authentication data to the second web site (passing, claim 8) and transmitting result of the authentication at the second web site to the first web site (receiving, claim 8). Claim 9 specifies that a user name and password are used, as opposed to the instant claim 4's "something a user knows" and also specifies (in claim 8) the

storing of a seed value and verifying the user's token code was generated by the user's token, as opposed to the instant claim 4's "authenticating". However, broadening these is obvious for the benefit of increased breadth. Further, the instant claim 4 specifies the Internet. However, it is well known in the art to use the Internet to transmit data between web sites, as the world wide web is part of the Internet and therefore this limitation is an obvious modification of '921's claim 9. Lastly, '921's claim 9 recites authorizing access per a successful authentication, where the instant claim 4 recites restricting access upon unsuccessful authentication. These are obvious modifications of each other.

Regarding claim 5, '921's claim 8 discloses this limitation (authenticating ..., claim 8).

Regarding claim 8, '921's claim 9 discloses this limitation (passing the user's token code ..., claim 9).

Regarding claim 9, '921's claim 9 discloses a password.

18. In the above analysis, other differences in the claims are a matter of wording and do not reflect a patentable distinction based on scope.

19. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. SIMITOSKI whose telephone number is (571)272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Michael J Simitoski/
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